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EXAMINER

IP, SIKYIN

ART UNIT

PAPER NUMBER

1742

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19

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|-----------------|----------------|
| Office Action Summary | Application No. | Applicant(s) |
| | Examiner | Group Art Unit |

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

Responsive to communication(s) filed on 8/28/02

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

Claim(s) 1, 4-7, 10-13, 16-20 is/are pending in the application.

Of the above claim(s) _____ is/are withdrawn from consideration.

Claim(s) _____ is/are allowed.

Claim(s) 1, 4-7, 10-13, 16-20 is/are rejected.

Claim(s) _____ is/are objected to.

Claim(s) _____ are subject to restriction or election requirement.

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The proposed drawing correction, filed on _____ is approved disapproved.

The drawing(s) filed on _____ is/are objected to by the Examiner.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All Some* None of the CERTIFIED copies of the priority documents have been received.

received in Application No. (Series Code/Serial Number) _____.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Attachment(s)

Information Disclosure Statement(s), PTO-1449, Paper No(s). _____ Interview Summary, PTO-413

Notice of Reference(s) Cited, PTO-892 Notice of Informal Patent Application, PTO-152

Notice of Draftsperson's Patent Drawing Review, PTO-948 Other _____

Office Action Summary

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1, 4-7, 10-13, and 16-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 6258317. Although the conflicting claims are not identical, they are not patentably distinct from each other because the alloy compositions in instant claims are overlapped by the alloy compositions of said patent.

Claim Rejections - 35 USC § 103

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1, 4-7, 10-13, and 16-20 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103 as being unpatentable over USP 4764225 to Shankar et al (col. 3, lines 7-50 and col. 4, lines 8-24) or USP 3015558 to Grant (col. 2, lines 5-54).

6. The cited references disclose the features substantially as claimed. The disclosed features include the claimed Ni-Cr-Co alloy. Therefore, the subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have selected the overlapping portion of the subject matter disclosed by the reference. Overlapping ranges have been held to be a *prima facie* case of obviousness, See MPEP § 2112.01, *In re Best*, 195 USPQ 430, *In re Malagari*, 182 USPQ 549, *In re Titanium Metals Corporation of America v. Banner*, 227 USPQ

773 (Fed. Cir. 1985), In re Woodruff, 16 USPQ 2d 1934, and In re Wertheim, 541 F.2d 257, 191 USPQ 90 (CCPA 1976).

7. Grant teaches about 28-45 wt.% Cr which is about the same as claimed Cr contents. See In re Preda, 159 USPQ 342 and In re Ayers, 154 F 2d 182, 69 USPQ 109 (CCPA 1946). Moreover, it is well settled that a prima facie case of obviousness would exist where the claimed ranges and prior art do not overlap but are close enough that one skilled in the art would have expected them to have the same properties, In re Titanium Metals Corporation of America v. Banner, 227 USPQ 773 (Fed. Cir. 1985), In re Woodruff, 16 USPQ 2d 1934, and In re Aller, 105 USPQ 233.

8. With respect to the N content in claim 1, that the claimed N content reads on zero, which suggests N could be eliminated from the claimed alloy.

9. With respect to the N content in claims 7 and 13, that the claimed N contents read on trace or impurity amount that would diffuse into the alloy during casting under N insert atmosphere or ambient atmosphere. Nonetheless, Grant in col. 2, lines 37-41 teaches N could be added as optional element to form nitrides (paragraph bridging col. 9-10). It has been held that combining known ingredient having known functions, to provide a composition having the additive effect of each of the known functions is within realm of performance of skilled artisan and is not a patentable

subject matter. *In re Castner*, 186 USPQ 213 (217). The use of conventional materials to perform their known functions in a conventional process is obvious. *In re Raner*, 134 USPQ 343 (CCPA 1962).

Response to Arguments

10. Applicant's arguments filed August 28, 2002 have been fully considered but they are not persuasive.

11. Applicants' argument in pages 6-8 and 10-12 is noted. However, criticalities of elements' contents must be established by factual evidence. Mere argument or conclusory statements in the specification is not sufficient. *In re Geisler*, 116 F.3d at 1470. Comparison must be done under identical condition except for the novel features of the invention. *In re Brown*, 173 USPQ 685 and *In re Chapman*, 148 USPQ 711. The showing of unexpected results must be occurred over the entire claimed range. *In re Clemens*, 622 F.2d 1029, 206 USPQ 289, 296 (CCPA 1980). The scope of the showing must be commensurate with the scope of the claims. *In re Tiffin*, 448 F.2d 791, 792 (Fed. Cir. 1971), *In re Coleman*, 205 USPQ 1172, and *In re Greenfield*, 197 USPQ 227.

12. Applicants' argument with respect to Shankar in paragraph bridging pages 6-7 of the instant remarks is noted. But, overlapping ranges have been held to be a prima

facie case of obviousness, See *In re Best*, 195 USPQ 430, *In re Malagari*, 182 USPQ 549, *In re Titanium Metals Corporation of America v. Banner*, 227 USPQ 773 (Fed. Cir. 1985), *In re Woodruff*, 16 USPQ 2d 1934, and *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976).

13. Applicants argue that Shankar does not disclose the criticality of the Zr, Y, Ti, Mo, Co, Cr ranges for the corrosion properties in various environments. First, there is no factual evidence that the claimed element range is critical. Second, the alloy of Shankar is also directed to reduce oxidation and hot corrosion resistance (see abstract and col. 3, lines 7-35).

14. Applicants argue that the Cr content of Grant's alloy (about 28-45 wt.%) is much higher than 22-27 wt.%. But, Grant teaches "about 28 wt.%" which reads on the claimed 26 and 27 wt.% in claims 20 and 1 respectively. The wording "about" allows up to 10% difference. See *In re Preda*, 159 USPQ 342 and *In re Ayers*, 154 F 2d 182, 69 USPQ 109 (CCPA 1946).

15. Applicants argue that alloy of Grant does not contain Zr or Y. Applicants' attention is directed to col. 2, lines 46-48 which disclose Zr content from effective amount to about 0.3 wt.%. and lines 45-46 disclose rare earth elements up to about 0.2 wt.%. Ordinary skill artisan knows Y is one of the rare earth.

16. Applicants argue the claimed Zr content is critical. The unexpected result is

shown in Table 9, page 11 of the instant specification. The examiner disagrees. The composition of alloy A is very different from the other alloys 1-9 (see Table 2, in page 5 of the instant specification). For example, the alloy A does not contain B, Hf, and/or Y elements. Furthermore, the Al and Nb contents of alloy A are much lower than the other alloys 1-9. Thus, the effect of sulfidation resistance due to Zr in Table 9 cannot be clearly found. Comparison must be done under identical condition except for the novel features of the invention. *In re Brown*, 173 USPQ 685 and *In re Chapman*, 148 USPQ 711. The showing of unexpected results must be occurred over the entire claimed range. *In re Clemens*, 622 F.2d 1029, 206 USPQ 289, 296 (CCPA 1980). The scope of the showing must be commensurate with the scope of the claims. *In re Tiffin*, 448 F.2d 791, 792 (Fed. Cir. 1971), *In re Coleman*, 205 USPQ 1172, and *In re Greenfield*, 197 USPQ 227.

17. Applicants' argument in page 9 of the instant remarks is noted. But, the different of Mo content is not merely 0.05 wt.% different in the Titanium Metals Corporation case. In fact, it is 20% different ($0.05 \text{ wt.\%} / 0.25 \text{ wt.\%} \times 100\%$). For the instant case, the difference between the claimed Cr (27 wt.%) and Cr from Grant (28 wt.%) is less than 10% which is much less than 20% as in said court case.

18. Applicants argue that the wording "about" has been deleted from instant claims. But, the wording "about" is also recited in Grant (see col. 2, line 8).

Conclusion

19. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

The above rejection relies on the reference(s) for all the teachings expressed in the text(s) of the references and/or one of ordinary skill in the metallurgical art would have reasonably understood or implied from the text(s) of the reference(s). To emphasize certain aspect(s) of the prior art, only specific portion(s) of the text(s) have been pointed out. Each reference as a whole should be reviewed in responding to the rejection, since other sections of the same reference and/or various combination of the cited references may be relied on in future rejection(s) in view of amendment(s).

All recited limitations in the instant claims have been met by the rejections as set forth above.

Applicant is reminded that when amendment and/or revision is required, applicant should therefore specifically point out the support for any amendments made to the disclosure. See MPEP § 2163.06 (a) and 37 C.F.R. § 1.121.

Examiner Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to S. Ip whose telephone number is (703) 308-2542. The examiner can normally be reached on Monday to Friday from 5:30 A.M. to 2:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Roy V. King, can be reached on (703)-308-1146.

The facsimile phone numbers are (703) 872-9310 (non-final Official Paper only), (703) 872-9311 (after-final Official Paper only), and (703) 305-7719 (Unofficial Paper only). When filing a FAX in Technology Center 1700, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communication with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0651.


SIKYIN IP
PRIMARY EXAMINER
ART UNIT 1742

S. Ip

November 17, 2002